

REMARKS

The Examiner's Office Action of July 6, 2000 in the parent case has been carefully reviewed and a diligent effort has been made to respond to the objections and rejections contained therein. Claims 2, 7, 51, 52, 53, and 55 have been cancelled, without prejudice, in order to reduce the remaining issues in this application. Claims 1, 4, 5, 6, 8, 9, 16, 21, 54, 56 and 57 have been amended to more particularly point out and distinctly claim the invention in view of the newly cited references, and also to put the application into a better form for consideration in the event of an appeal. New claims 58-83 have been added for initial consideration in this continuing application.

I. Rejection of Claims 1-2, 4, 11, 13, 19-20, 51 and 54 over Macko

In paragraph 2 of the Office Action, the Examiner rejected claims 1-2, 4, 11, 13, 19-20, 51 and 54 under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,052,563 to Macko ("Macko"). Applicants respectfully traverse the rejection of claims 1, 4, 11, 13, 19-20 and 54 over Macko in view of the claim amendments set forth above and the remarks below. Claims 2 and 51 have been cancelled and thus further discussion of the rejection with respect to these claims is moot.

Macko describes a communication device that can be synchronized with an appointment book application operating on a personal computer ("PC"). The PC in Macko includes a companion software program that synchronizes the appointment book of the PC with a corresponding appointment book in the communication device. Macko also discloses an E-mail forwarding application operating in conjunction with the appointment book at the PC. A software flag is set in the PC to activate the E-mail forwarding application so that E-mail messages received at the PC are forwarded to the communication device during the duration of a scheduled appointment that has been entered into the appointment book. (Column 8, lines 48-67)

mobile data communication device is at, or nearby, the host system and is generating reply messages at the host system. In reality, however, the user is not at the host system, but instead is generating reply messages using the mobile communication device. So, instead of being at the host system, the user could be on the beach, playing golf, or anyone else away from the host system. By implementing the steps set forth in claim 1, the messages from the plurality of senders and the reply messages from the mobile data communication device are transparently redirected to and from the mobile device so that it appears to the message senders that the user of the mobile device is at the host system.

Macko does not disclose or suggest this two-way “transparency” concept. Indeed, Macko is silent regarding the processing of any reply E-mails that might be generated at the communication device. Thus, Macko does not disclose or suggest at least steps (F), (G), and (H) of claim 1, and therefore this claim is patentably distinct from Macko. Reconsideration of the rejection is respectfully requested.

Claims 4, 11, 13, 19 and 20 depend from amended claim 1, and therefore are patentably distinct from Macko for at least the same reasons as claim 1.

Claim 54 is an independent claim that recites a method of redirecting electronic data items from a host system operated by a user to the user’s mobile data communication device.

The method includes the following steps:

(A) configuring an external redirection event at the host system, wherein the external redirection event is the host system sensing whether the user is in the vicinity of the host system;

(B) receiving electronic data items at the host system; and

(C) if the host system senses that the user is not in the vicinity of the host system, then continuously redirecting the received data items to the user’s mobile data communication device until the host system senses that the user is in the vicinity of the host system.

Turning now to the amended claims set forth above, claim 1 recites a method of redirecting messages between a host system and a mobile data communication device. The method of claim 1 includes the following steps:

- (A) configuring one or more redirection events at the host system;
- (B) detecting that a redirection event has occurred at the host system and generating a redirection trigger;
- (C) receiving messages at the host system from a plurality of message senders;
- (D) in response to the redirection trigger, continuously redirecting the messages from the host system to the mobile data communication device;
- (E) receiving the messages at the mobile data communication device;
- (F) *generating reply messages at the mobile data communication device to be sent to the plurality of message senders and transmitting the reply messages to the host system;*
- (G) *receiving the reply messages at the host system and configuring address information of the reply messages so that the reply messages appear to have been generated at the host system instead of at the mobile data communication device; and*
- (H) *transmitting the reply messages from the host system to the plurality of message senders.*

Without conceding that Macko discloses or suggests any of the steps set forth in claim 1, it is clear that Macko does not disclose or suggest *at least* steps (F), (G), and (H). These steps describe a process of replying to a message that has been redirected from the host system to the mobile data communication device in a way that the reply message appears to have been generated at the host system instead of at the mobile data communication device.

One aspect of the present invention is the concept of “transparency” of the mobile device to the plurality of message senders. This concept, as well as others, are described in the application at page 6, lines 5-18, page 15, lines 9-20, and page 24, lines 4-10. Simply put, the “transparency” concept makes the plurality of message senders believe that the user of the

Macko does not disclose or suggest at least steps (A) and (C) of claim 54. Step (A) sets forth the configuration of an “external redirection event” at the host system, wherein the “external redirection event” is the host system *sensing* whether the user is in the vicinity of the host system. In response to this “external redirection event” the host system continuously redirects the received data items to the user’s mobile data communication device until the host system *senses* that the user returns to the vicinity of the host system.

Macko only discloses the provision of an appointment entry in an appointment book application, which, when the appointment time arrives, causes the PC to forward E-mail to the communication device. This step in Macko, however, is not the same as step (A) in claim 54. First, the appointment entry is not an “external redirection event,” as this term has been defined in the present invention. An “external event” is a detectable occurrence that is external to the host system. By distinction, an “internal event” is a detectable occurrence that is internal to the host system. An example of an “internal event” given in the present application is a calendar alarm, i.e., an appointment entry. (See, page 12, lines 1-14, for example.) Thus, as described and claimed in the present invention, an appointment entry is not an “external event,” but rather is an “internal event.”

Second, the PC in Macko does not “sense” whether the user is in the vicinity of the PC, but instead relies on the information stored in the appointment entry. As described in the present application, the “sensing” of whether the user is in the vicinity of the host system or not is an “external event” that is sensing whether or not the user is physically nearby the host system or not. Macko’s PC does not know whether the user is in the vicinity of the PC or not, i.e. it does not “sense” anything. Instead, Macko’s PC merely infers that the user is gone because of the appointment entry. But the user could have input an appointment entry for a particular time, and

then decided not to attend the appointment. In this situation, Macko's PC would still begin forwarding E-mail even though the user is sitting in front of the PC. Macko simply does not disclose or suggest the "sensing" step as set forth in claim 54. Reconsideration is respectfully requested.

II. Rejection of Claims 1-2, 4-6, 11-13, 16, 51 and 52

In paragraph 3 of the office action, the Examiner rejected claims 1-2, 4-6, 11-13, 16, 51 and 52 under 35 U.S.C. § 102(b) as being unpatentable over EP Patent Application No. 0772327 A2 to the Sharp Corporation ("Sharp"). Applicants respectfully traverse the rejection of claims 1, 4-6, 11-13 and 16 over Sharp in view of the claim amendments set forth above and the remarks below. Claims 2, 51 and 52 have been cancelled and thus further discussion of the rejection with respect to these claims is moot.

Sharp describes a mail forwarding system that operates between a single mail communication terminal (or computer) and a portable wireless device. E-mail messages are received and stored at the mail communication terminal. The user of the portable wireless device can send a forwarding-request signal to the mail communication terminal in order to enable the forwarding of E-mail to the portable wireless device. The forwarding-request signal may include a predetermined forwarding time and time interval during which E-mails are forwarded to the portable wireless device.

As described above, Claim 1, as amended, recites a method of redirecting messages between a host system and a mobile data communication device. The method of claim 1 includes the following steps:

(A) configuring one or more redirection events at the host system;

(B) detecting that a redirection event has occurred at the host system and generating a redirection trigger;

- (C) receiving messages at the host system from a plurality of message senders;
- (D) in response to the redirection trigger, continuously redirecting the messages from the host system to the mobile data communication device;
- (E) receiving the messages at the mobile data communication device;
- (F) *generating reply messages at the mobile data communication device to be sent to the plurality of message senders and transmitting the reply messages to the host system;*
- (G) *receiving the reply messages at the host system and configuring address information of the reply messages so that the reply messages appear to have been generated at the host system instead of at the mobile data communication device;* and
- (H) *transmitting the reply messages from the host system to the plurality of message senders.*

Without conceding that Sharp discloses or suggests any of the steps set forth in claim 1, it is clear that Sharp, like Macko, does not disclose or suggest at least steps (F), (G), and (H). Sharp, like Macko, is silent regarding the processing of any reply E-mails that might be generated at the communication device. Sharp, like Macko, does not disclose or suggest the two-way “transparency” concept of the present invention discussed more fully above in which messages from the plurality of senders and the reply messages from the mobile data communication device are transparently redirected to and from the mobile device so that it appears to the message senders that the user of the mobile device is at the host system. Thus, Sharp does not disclose or suggest at least steps (F), (G), and (H) of claim 1, and therefore this claim is patentably distinct from Sharp. Reconsideration of the rejection is respectfully requested.

Claims 4-6 depend from claim 1 and were rejected by the Examiner over Sharp. Claim 4 has now been amended to recite the additional step of: “*storing* information regarding the configuration of the mobile data communication device *at the host system.*” Claim 5 has been amended to indicate that the information “stored at the host system” includes: (A) the network address of the mobile data communication device; and (B) an indication of the types of message

attachments that the mobile data communication device can receive and process. Claim 6 has been amended to indicate that the information “stored at the host system” further includes: (C) an indication of the type of mobile data communication device.

None of these additional steps are disclosed or suggested by Sharp. Sharp does not disclose or suggest the step of “storing” configuration information regarding the mobile device “at the host system,” nor does Sharp disclose or suggest “storing” configuration information “at the host system” that includes the three elements (A), (B) and (C) set forth in claims 5 and 6. The sections of Sharp pointed to by the Examiner do not disclose these elements. These claims are therefore patentably distinct from Sharp. Reconsideration is respectfully requested.

Claims 11-13 depend from amended claim 1 and therefore are patentably distinct from Sharp for at least the same reasons as claim 1.

Claim 16 depends from amended claim 1 and claim 11, and was rejected by the Examiner over Sharp. This claim has now been amended to indicate that the network events recited in claim 11 include “messages to begin redirection from computer systems other than the mobile data communication device, which are connected to the host system via a wired network.” This limitation is not disclosed or suggested by Sharp, and therefore this claim is patentably distinct from Sharp. Reconsideration is respectfully requested.

III. Rejection of Claims 8 and 53

In paragraph 5 of the Office Action, the Examiner rejected claims 8 and 53 under 35 U.S.C. § 103(a) as being unpatentable over Macko in view of United States Patent No. 6,023,700 to Owens (“Owens”) and further in view of PCT Publication WO 97/33421 to Pepe (“Pepe”). Claim 53 has now been cancelled from this application. Claim 8 is patentably distinct from Macko, Owens and Pepe for at least the same reasons as set forth above with respect to claim 1.

IV. Rejection of Claims 7 and 9

In paragraph 6 of the Office Action, the Examiner rejected claims 7 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Sharp in view of the article “Wireless E-Mail services. . .” from the April 17, 1995 edition of PC Week (“WyndMail”). Claim 7 has now been cancelled by this Amendment, although the limitation from claim 7 has been included in amended claim 5. Therefore, in traversing the rejection of claim 7, these remarks will be directed to amended claim 5.

Claim 5, as amended, indicates that the configuration information “stored at the host system” includes: (A) the network address of the mobile data communication device; and (B) an indication of the types of message attachments that the mobile data communication device can receive and process. Claim 5 depends from claim 4, which depends from amended claim 1.

As noted above, Sharp does not disclose or suggest storing any configuration information regarding the mobile device at the host system, let alone the specific information set forth in amended claim 5. The WyndMail reference does not disclose these steps either. The Examiner contends that WyndMail discloses “an e-mail forwarding system for forwarding messages to a mobile user, wherein it is determined whether messages of a specific type (i.e. binary) can be received and processed at a mobile device” (pointing to p. 1, last paragraph of the reference.) With all due respect, the Examiner appears to be reading too much into the WyndMail reference. All WyndMail teaches is that users can forward messages to other mailboxes, such as binary attachments, which may be too lengthy for the mobile device to process. Claim 5, however, as amended, recites the step of storing configuration information at the host system including “(B) an indication of the types of message attachments that the mobile data communication device can receive and process.” This step is not disclosed or suggested in WyndMail.

Claim 9 depends from claim 7 and further includes the steps of: (A) for each message to be redirected, the host system determining whether the message includes an attachment, and if so then determining the type of attachment; (B) accessing the stored configuration information at the host system to determine whether the mobile data communication device can receive and

process attachments of the determined type; and (C) if so, then redirecting the attachments to the mobile data communication device, and if not, then redirecting the attachments to a device that is capable of processing the attachment. None of these steps in claim 9 are disclosed or suggested by Sharp or WyndMail. Again, all WyndMail teaches is manually forwarding of attachments to some other mailbox. It does not disclose or suggest any of the automated attachment processing steps set forth in claim 9. Without such a disclosure in at least one of Sharp or WyndMail, the Examiner has failed to make out a *prima facie* case of obviousness and thus the rejection is improper. Reconsideration is respectfully requested.

V. Rejection of Claim 10

In paragraph 7 of the Office Action, the Examiner rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Sharp in view of WyndMail and the article to Arnum. Claim 10 depends from claims 9, 5 and 1, and therefore is patentably distinct from the cited references for at least the same reasons noted above with respect to these claims.

VI. Rejection of Claims 14 and 56

In paragraph 8 of the Office Action, the Examiner rejected claims 14 and 56 under 35 U.S.C. § 103(a) as being unpatentable over Sharp in view of United States Patent No. 5,819,284 to Farber ("Farber"). Applicants respectfully traverse the rejection of these claims.

Sharp has been described previously. Farber describes a personalized real-time display of information that is integrated into a screen-saver. In Farber, a plurality of information "feeds" from multiple information sources are aggregated, formatted and stored in a real-time information display system. A user computer system, such as a personal computer, operates a screen saver program. When the screen saver program is activated, a message is transmitted from the user's computer system (where the screen saver program is operating) to the real-time information display system in order to obtain particular information "feeds" that are stored at the real-time information display system. These information "feeds" are then displayed through the screen saver program at the user's computer system.

Claim 14 depends from claim 11, which depends from claim 1, and adds the further limitation that the internal event that triggers redirection of messages from the host system to the mobile data communication device is a screen saver activation. Claim 14 is patentably distinct from Sharp and Farber for at least the same reasons as claim 1.

Claim 56, as amended, describes a method of redirecting messages from a desktop computer system to a mobile data communication device associated with the desktop system. The method of claim 56 includes the following steps:

- (A) providing a message redirection program *at the desktop system*;
- (B) providing a screen saver program *at the desktop system*;
- (C) *linking the screen saver program to the message redirection program*; and
- (D) *if the message redirection program detects that the screen saver is activated, then continuously redirecting messages from the desktop computer system to the mobile data communication device until the message redirection program detects that the screen saver is deactivated.*

In claim 56, as amended, both the message redirection program and the screen saver program are operating *at the desktop system*. These two program are *linked* such that if the message redirection program detects that the screen saver program is activated, it then continuously redirects messages from the desktop system to the mobile data communication device until the message redirection program detects that the screen saver is deactivated. This configuration of the host system and these specific method steps are not disclosed or suggested in either Sharp or Farber.

Sharp does disclose a message forwarding system for forwarding messages from a desktop system to a mobile device. But Sharp does not disclose any type of screen saver program linked to the forwarding program for enabling and disabling the forwarding of messages from the host system to the mobile device. Farber does disclose a screen saver program, but Farber's screen saver program has nothing to do with enabling and disabling a forwarding program at the desktop system. Instead, the Farber screen saver causes a message to be sent to some other computer (not the desktop system where the screen saver is operating) in order to

obtain information from the other computer. Thus, Sharp and Farber are directed to two very different types of systems, and the Examiner has pointed to nothing in either of these references that would motivate one of skill in the art to combine their teachings. Therefore, the Examiner has failed to make out a *prima facie* case of obviousness and the rejection is improper. Reconsideration is respectfully requested.

VII. Rejection of Claim 15

In paragraph 9 of the Office Action, the Examiner rejected claim 15 as being unpatentable over Sharp and Farber, in view of Japanese Patent No. JP409305155A to Yamamoto ("Yamamoto"). Claim 15 depends from claim 11, which depends from claim 1, and therefore this claim is patentably distinct from the cited references for at least the same reasons as claim 1.

In addition, claim 15 recites a keyboard timeout signal that triggers redirection of messages from the host system to the mobile data communication device. This feature is not disclosed or suggested by any of the references cited by the Examiner. Sharp does not disclose this feature. Farber only teaches a screen saver program that activates the obtaining of information from some other computer, not the redirection of messages from a host system to a mobile data communication device, as further described above with respect to claims 14 and 56. And Yamamoto only relates to a keyboard timeout for a screen saver program. Claim 15 has nothing to do with a screen saver program, and thus Farber and Yamamoto are irrelevant to the claimed subject matter. There is no disclosure or suggestion in any of the references cited by the Examiner to trigger redirection of messages from a host system to a mobile data communication device using a keyboard timeout signal as the triggering event. Reconsideration is respectfully requested.

VII. Rejection of Claims 21-26

In paragraph 10 of the Office Action, the Examiner rejected claims 21-26 under 35 U.S.C. § 103(a) as being unpatentable over Sharp in view of United States Patent No. 5,978,837 to Foladare. Claims 21-26 depend from claim 1, and therefore are patentably distinct from the references cited for at least the same reasons as claim 1.

VIII. Rejection of Claim 55

Claim 55 has been cancelled by this Amendment and thus further discussion of this claim is unnecessary.

IX. Rejection of Claim 57

In paragraph 12 of the Office Action, the Examiner rejected claim 57 under 35 U.S.C. § 103(a) as being unpatentable over Sharp in view of United States Patent No. 5,995,597 to Woltz ("Woltz"). Applicants respectfully traverse the rejection.

Claim 57, as amended, recites a method of redirecting data items from a server system *to a plurality of mobile data communication devices*. The method of claim 57 includes the following steps:

- (A) *providing a redirection program at the server system;*
- (B) providing a plurality of desktop systems in communication with the server system via a network;
- (C) providing a user profile for each of the plurality of desktop systems at the server system, wherein the user profiles each associate a particular desktop system with a particular mobile data communication device;
- (D) configuring the desktop systems to detect redirection events;
- (E) detecting the redirection events at the desktop systems;
- (F) *transmitting redirection messages from the desktop systems to the server system;* and

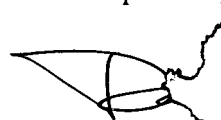
(G) continuously redirecting the data items from the server system to the mobile data communication devices based on the user profiles.

Without conceding that Sharp or Woltz disclose or suggest any of the steps set forth in claim 57, it is certain that neither of these references disclose or suggest at least steps (A), (F) and (G). Claim 57 describes a network redirection system in which the redirector program is operating at a network server. The network server includes a profile for each user that is authorized to have messages redirected through the system. The profile associates the user's desktop system with their mobile data communication device. Each of the users configures one or more redirection events at their own desktop system, such as a screen saver, calendar alarm, sensing whether the user is in the vicinity of the desktop system, etc. Upon detecting one of the redirection events at a particular desktop system, that desktop system then transmits a redirection message to the network server where the redirector program is operating. The network server then uses the user profile to determine which user transmitted the redirection message, and in response continuously redirects any data items for that user from the server to the user's mobile data communication device.

The references cited by the Examiner do not disclose or suggest the method set forth in claim 57. Specifically, none of the references used by the Examiner in rejecting claim 57 disclose or suggest steps (A), (F) and (G). Therefore, claim 57 is patentably distinct from the cited references and reconsideration of the rejection is respectfully requested.

In view of the foregoing claim amendments and remarks, applicants believe that this application is now in condition for allowance.

Respectfully submitted,



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